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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,956	02/19/2002	Shuichi Hirayama	SN-US025009	3435
22919	7590	06/10/2005	EXAMINER	
SHINJYU GLOBAL IP COUNSELORS, LLP 1233 20TH STREET, NW, SUITE 700 WASHINGTON, DC 20036-2680			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/076,956	<b>Applicant(s)</b> HIRAYAMA, SHUICHI	
	<b>Examiner</b> Anthony Stashick	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 March 2005 and 14 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,6-13 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6-13 and 15-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Finality Of Previous Office Action***

1. Based upon the Decision of the Petition on March 30, 2005, the finality of the previous Office Action has been withdrawn. The amendment filed December 14, 2004 has been entered and an Office Action on the merits of the pending claims is set forth below. Accordingly, claims 6-13 and 15-28 are still pending in the application.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 6-7, 9-13, 17-21, 23 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pozzobon 6,012,236 in view of Garbuio 3,925,916 and Clement et al. 5,746,015. Pozzobon '236 discloses a boot liner 2 with a sole portion (see Figure 1); the boot liner having an upper portion having a foot section fixedly coupled to the sole portion (see Figure 1); an ankle section extending upwardly from the foot section (also see Figure 1); a leg section extending upwardly from the ankle section (see Figure 1); the upper portion including a thermoformable layer located on an inner side and an outer side of the ankle section 103; the thermoformable layer extends along the foot section (see Figure 1); the thermoformable layer extends along the leg section (see Figure 1); the sole portion being made of the thermoformable material (same as the upper). Pozzobon '236 does not teach the banana-shaped pads located near

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the ankles and the limitations associated with the banana-shaped pads. Garbuio '916 discloses a first banana-shaped pad 108 located in the outer side of the ankle section; a second banana-shaped pad 108 located in the inner side of the ankle section; the banana-shaped pads made of different material than the upper and formed of polyurethane; the upper portion includes a foam layer disposed on an interiorly facing side of the thermoformable layer (inner boot layer); the upper portion includes an outer layer disposed on an exteriorly facing side of said thermoformable layer; the sole portion is a separate member that is coupled to the foot section of the upper portion; the sole portion is constructed of a flexible material; the sole portion includes an outer sole section that is fixedly coupled to said foot section of the upper; the outer sole section of the sole portion includes an exterior layer of PVC material; the outer sole section of the sole portion further includes an interior thermoformable layer; the banana-shaped pads have a maximum vertical height and a maximum horizontal width that is approximately equal to the maximum vertical height. Garbuio '916 teaches that it is desirable to have these pads located on the inner boot to allow for a better and more snug fit of the boot to the user's foot. Therefore, it would have been obvious, to one of the ordinary skill in the art at the time the invention was made, to place banana-like pads, such as that taught by Garbuio '916, on the liner of Pozzobon '236, to aid in better fitting the liner to the user's foot to better translate the forces applied to the sole of the boot. The references as applied immediately above disclose all the limitations of the claim except for the upper portion includes an inner layer disposed on an interiorly facing side of the thermoformable layer with the first and second banana-shaped pads located between the thermoformable layer and the inner layer. Clement et al. '015 teaches that the upper portion of a liner can have an inner layer 12 disposed on an interiorly facing side of an outer upper layer 11

with padding 5 located there between. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place an inner layer inside the thermoformable layer with the banana-like pads located there between to provide for better and proper cushioning of the boot on the user's foot.

4. Claims 8, 15, 16, 22, 24-25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied above in view of Breuner 5,775,006. The references as applied above disclose all the limitations of the claims except for the tightening device fixed to the upper with a first strap portion overlying a part of the first banana-shaped pad and a second strap portion overlying a part of second banana-shaped pad and the tongue and inner sole. Breuner '006 teaches that an inner sole section 46 can overlie the outer sole portion 14 to aid in gaining user comfort. Breuner '006 further teaches that a boot liner can have a tongue 48 attached thereto to close the slit in the boot to prevent ingress of unwanted material into the boot. Furthermore, Breuner '006 teaches that a strap portion can overlie a boot insert and aid in attaching the outer boot to the inner boot, thereby closing the inner boot and aiding in the prevention of ingress of unwanted material with the tongue. Therefore, it would have been obvious, to place a tongue on the inner boot upper as well as straps to attach the outer boot to the inner boot and prevent the ingress of material into the boot.

#### ***Response to Arguments***

5. Applicant's arguments filed December 14, 2004 have been fully considered but they are not persuasive. Applicant argues that the strap portions are not part of the liner as shown in

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Breuner. This argument is not clearly understood. Breuner clearly shows the loop portion of the straps in Figure 6 as part of the liner, thereby making the straps themselves part of the liner. The combination of Breuner with the other references as noted in the rejections above clearly show the straps overlying the banana-shaped pads and is clearly capable of overlapping banana-shaped pad in the ankle section because the straps of Breuner cross in this section (see Figure 5). Applicant further argues that the combination of references currently used is not disclosed in the references applied and therefore these references cannot be combined. This argument is also clearly not understood. The references, when taken as a whole, teach the claimed invention inasmuch as that noted in the rejections set forth above. It appears that applicant describes each reference for what it does not teach of the applicant's invention rather than what each references teach as a whole. Applicant further argues that the banana-shaped pad 8 of Garbuio is not part of the liner. This argument is also not clearly understood. Garbuio clearly states in col. 2, line 28- that "As further shown in Figure 1, a pair of elastic pads 8 (one on each side) may be juxtaposed with the insert 2 in the region of the ankles for additional protection..." Since the pads can be considered part of the insert in the way they are used in Garbuio, these pads 8 meet the banana-shaped limitation of the claims. Applicant further argues that claim 13 requires that the boot liner with an ankle section having a banana-shaped pad located *in* the outer side of the ankle section etc. and says that Garbuio does not meet this limitation in the claim. This argument is also not clearly understood. It appears that applicant is arguing more than that which is disclosed. Applicant has not claimed the banana-shaped pads being located **inside** the outer side but only in, in it's broadest reasonable interpretation to mean "in the area of". Therefore, this limitation is clearly met by Garbuio. With respect to the arguments directed to Clement et al.,

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once again it appears applicant is describing the reference for what it does not teach of the applicant's invention rather than what the reference teaches as a whole.

### *Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

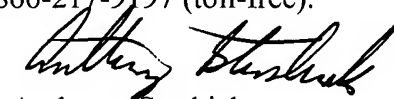
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS